REMARKS

The Restriction Requirement

The pending claims, claims 1-6 and 25-67, are subject to a Restriction Requirement in which the claims were assigned to eight different groups. Applicant submits that the Restriction Requirement is in error and should be modified as follows.

Request for Reconsideration

Applicant respectfully submits that the claims of Group I (claims 1-6, 25, and 51-58) and Group IV (claims 31 and 32) should be examined together. The claims of Group I are drawn to a product (a peptide of at least 9 amino acids in length derived from the tandem repeat domain of MUC1 and having the amino acid sequence SAP at its N-terminus), while the claims of Group IV are drawn to a product by process (e.g., the product of claims 1-6, 25, and 51-58 made by the method recited in claim 27). The Office states:

> Inventions of Groups I, II, IV, and VII represent separate and distinct products which are made by materially different methods, and are used in materially different methods which have different modes of operation, different functions and different effects...The peptide of Group I can be produced by linking amino acids via peptide bonds and can be used for antibody synthesis..., while the peptide of Group IV is produced by providing a peptide comprising tandem repeat domain of MUC1 or a part thereof and contacting the peptide with an effective amount of cathepsin-L and can be used for diagnostic purposes.

(Office Action, p. 4). The Office concludes that the inventions of Groups I and IV are not so linked as to form a single general inventive concept under PCT Rule 13.1, and thus, "the examination of all groups would require different searches in the U.S. Patent shoes and the scientific literature and would require the consideration of different patentability issues" (Office Action, pp. 4-5). Applicant respectfully disagrees.

The claims of Groups I and IV should be examined together because the peptide products of claims 1-6, 25, 31, 32, and 51-58 share the same special technical features. The M.P.E.P. § 1850(I) states:

> Unity of invention exists only when there is a technical relationship among the claimed inventions involving one or more special technical features. The term "special technical features" is defined as meaning those technical features that define a contribution which each of the inventions considered as a whole, makes over the prior art. The determination is made based on the contents of the claims as interpreted in light of the description and drawings.

In this case, the claims of Groups I and IV are directed to the same peptide product or to a molecule that includes the peptide product. The peptide products share the same minimum length requirement (at least 9 amino acids in length), are based upon the same sequences (derived from the tandem repeat domain of MUC1), and have the same structural features (the amino acid sequence SAP at the N-terminus of the peptide). Thus, the peptide recited in the claims of Groups I and IV are not structurally and chemically different; they share the same special technical features. Accordingly, the claims of Groups I and IV should be examined together.

Because the claims of Groups I and IV are directed to peptide products having the same special technical features, an examination of the subject matter of the claims of these two groups would require the same search. Furthermore, Applicant notes that the subject matter of Group IV was considered during examination of the international application (PCT/EP03/09882) to have unity with the subject matter of Group I (see, e.g., International Search Report dated November 30, 2004). For this reason, it is believed that there would be no additional burden on the Office to search the subject matter of Groups I and IV together.

Finally, Applicant points out that the differing examples given by the Office for the uses of the peptides of Groups I and IV (i.e., a peptide for antibody synthesis and a peptide for diagnostic purposes, respectively) are not unique to the respective peptide products. In other words, the peptide of Group IV could just as readily be used to produce an antibody, while the peptide of Group I could be used for diagnostic purposes. Thus, the Office's conclusion that the peptide products of Groups I and IV represent separate and distinct products is in error and should not form the basis for restricting the inventions of Groups I and IV. The claims of Groups I and IV should be examined together.

CONCLUSION

Applicant respectfully requests reconsideration and withdrawal of the Restriction Requirement between Groups I and IV.

Enclosed is a petition to extend the period for replying to the Restriction Requirement for three months, to and including May 10, 2008.

If there are any charges or any credits, please apply them to Deposit Account No. 03-2095.

Respectfully submitted,

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